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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,785	10/17/2003	Neil D. Lubart	25762-35	9559
21130	7590	09/26/2006	EXAMINER	
BENESCH, FRIEDLANDER, COPLAN & ARONOFF LLP ATTN: IP DEPARTMENT DOCKET CLERK 2300 BP TOWER 200 PUBLIC SQUARE CLEVELAND, OH 44114			WOOD, KEVIN S	
			ART UNIT	PAPER NUMBER
			2874	
DATE MAILED: 09/26/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/688,785	<b>Applicant(s)</b> LUBART ET AL.	
	<b>Examiner</b> Kevin S. Wood	<b>Art Unit</b> 2874	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 and 36-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 36, 39 and 40 is/are rejected.
- 7) ☒ Claim(s) 9-17, 37, 38, 41 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **NON-FINAL REJECTION**

### ***Response to Amendment***

1. This action is responsive to the Amendment filed on 10 July 2006. Claims 18-35 have been cancelled. New claims 36-41 have been added. Claims 1-17 and 36-41 are pending in the application.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-6 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 7-8, 36, 39-40 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,766,076 to Nakama et al.

Referring to claims 1-4 and 7-8, the Nakama et al. reference discloses all the limitations of the claimed invention. The Nakama et al. reference disclose a collimating device including: a first transparent substrate (3) having a first surface and a second surface, the first transparent substrate having an index of refraction; a plurality of wave guide structures (4) provided in the first transparent substrate, the plurality of wave guide structures having an index of refraction different than the index of refraction of the first transparent substrate, each wave guide structure having a base associated with the first surface of the first transparent substrate, a second transparent substrate (1) having a first surface and a second surface wherein the first surface of the second transparent substrate is facing the first surface of the first transparent substrate (3), the second transparent substrate (1) having an index of refraction; and a plurality of exit control structures (11) provided in the second transparent substrate, the plurality of exit control structures having an index of refraction different than the index of refraction of the second transparent substrate, each exit control structure having a base associated with the first surface of the second transparent substrate, wherein the first surface of the first transparent substrate and the first surface of the second transparent substrate face each other such that each wave guide structure is generally aligned with each exit control structure thereby forming a collimating structure, wherein light (100) emanating from a first direction facing the second surface of the first transparent substrate is collimated as it exits adjacent collimating structures. See Fig. 2 of the reference, along with their respective portions of the specification. The guide substrate (3) is disclosed as being made from aluminosilicate glass, which has a refractive index and is known to

be transparent to light. The reference discloses that the substrates (1,2,3) are all index matched.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 5 and 6, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,766,076 to Nakama et al.

Referring to claim 5, the Nakama et al. reference does not appear to specifically disclose that the first and second transparent substrates are constructed of a polymer. However, the application does not appear to disclose the criticality or novelty associated

Art Unit: 2874

with forming a substrate from a polymer. Polymer substrates are well known within the optical waveguiding art and are known for being inexpensive and easy to manufacture. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a polymer material to form the substrates, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416.

Referring to claim 6, the Nakama et al. reference does not appear to specifically disclose that waveguide structure (optical fibers) have generally the same index of refraction as the exit control structures (lenses). It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a waveguide structure having generally the same refractive index as the exit control structures, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). It is clear that the index of refraction of the core and cladding of the optical fiber are result effective variables in the optical waveguiding art.

#### ***Allowable Subject Matter***

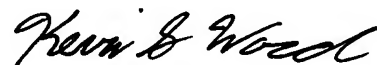
8. Claims 9-17, 37, 38 and 41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin S. Wood whose telephone number is (571) 272-2364. The examiner can normally be reached on Monday-Thursday (7am - 5:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney B. Bovernick can be reached on (571) 272-2344. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Kevin S. Wood  
Patent Examiner